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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,536	10/30/2003	Mary Ellet	D6501CIP	7582

7590

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EXAMINER
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PRICE, CARL D

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/697,536

Applicant(s)

ELLET, MARY

Examiner

CARL D. PRICE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the:

- telescoping slider mechanism,
- Velcro,
- a strap,
- tie-string,
- bracket,
- sewing,
- zippers,
- snaps,
- buttons, etc.

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- a first removable fabric cover,
- a second removable fabric cover,
- each of said adjustable decorative fabric covers having a length at least sufficient to cover said end sections and said center sections (claim 10),
- a second length of fabric (e.g. - claim 20).

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe a first removable fabric cover and a second removable fabric cover wherein each of the adjustable decorative fabric covers having a length at least sufficient to cover the end sections and the center sections.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-20: Rejected under 35 U.S.C. 112, second paragraph**

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claims 2-17 the term/phrase(s):

- “optionally, a side panel,” causes the claims to be confusing (claim 2);
- “optionally said fastening means” (claim 2);

Also, in regard to claims 2-20, the scope of the claimed invention is unclear. The preamble of the claim defines the invention as a “hearth guard” to cover a raised hearth. However, references within the body of the claims are made to “the raised hearth”. It is therefore unclear to what extent applicant intends the scope of the claimed invention to be directed to merely a hearth guard alone or the combination of a hearth guard and raised hearth.

In regard to claim 2, in particular, there is no proper antecedent basis for “said covered front panel” and “covered top and front panels”.

Regarding claims 1-17, the word "means" is preceded by the word(s) "connecting", “fastening” and “covering” in an attempt to use a "means" clause to recite a claim element as a

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means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

### **Double Patenting**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-5, 7-19 and 23-25 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of copending Application No. 10/423437. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

he has abandoned the invention.

the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

In regard to claim 1-17 the recitation "to cover a raised hearth" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, in regard to the claims 1-17 recitations, such as:

- "to encase an end of the raised hearth";

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- “to encase a center section of the raised hearth”;
- “is cut along a line”;
- “removable decorative”, etc.

are deemed recitations of intended use which have been given no patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In addition, the term “molded” (e.g. – claim 4) is deemed to be a method of process limitation which fails to further limit the apparatus claimed.

**Claims 1, 4, 7, 9, 10 and 13-16: Rejected under 35 U.S.C. 102(b)**

Claims 1, 4, 7, 9, 10 and 13-16, are rejected under 35 U.S.C. 102(b) as being anticipated by US 1713072 (BREMNER).

In regard to claims 1, 4, 7, 9, 10 and 13-16, US 1713072 (BREMNER) shows and discloses an adjustable cushioned guard comprising:

- a first end section (10),
- a second end section (10);
- an adjustable center section (11, 12);



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- each of said sections comprising a cushioning material (e.g. – cotton or wool felt);
- cloth covering means (29) for each of said panels;
- a telescoping slider bracket mechanism connecting means (e.g. 20-23, 24-27, 37, 38) to connect said sections; and
- fastening means (46,47).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-9 and 11-17**

Claims 1-9 and 11-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over US5639072 (MCCALL) in view of FR2691435 (GENDRE) and US4867135 (STECKER).

In regard to claims 1-9 and 11-17, US5639072 (MCCALL) shows and discloses an adjustable cushioned guard comprising:

- a first end section (Figure 7),
- a second end section (Figure 7);

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- each of said sections comprising a cushioning material (see column 4, line 34-42 and lines 63-65);
- an adjustable center section (column 8, lines 37-34);
- cloth covering means (16, 60) for each of said panels.

At column 8, lines 37-34, US5639072 (MCCALL) discloses:

“For example, with respect to the bumper 155 of FIGS. 23-30, it is apparent that the shape thereof, could be varied, so as to include the linear construction akin to that shown in FIGS. 1-6, elbow type like that shown in FIGS. 7-12 and a circular type akin to that shown FIGS. 13-22. **Furthermore, in system aspects of the invention, various lengths of different combinations of the embodiments of the invention could be used to provide full parameter protection of different table forms.** For example, the parameter of a rectangular table could include four elbow types shown in FIGS. 7-12 and FIGS. 23-30 at the corners of the table, and **a plurality of liner types of various lengths, say 12, 15, 18, 24 or 36 inches in lengths as shown in FIGS. 1-6 and FIGS. 23-30 between such corner to provide full parameter protection.** Likewise, round tables could use the circular type shown in FIGS. 13-22 and FIGS. 23-30 of various lengths, say 12, 15, 18, 24 or 36 inches to provide similar, full parameter table protection.”

US5639072 (MCCALL) discloses the invention substantially as set forth in the claims with possible exception to:

- a connecting means to connect said sections
- fastening means.

FR2691435 (GENDRE) teaches (see the English language abstract), from the same edge and/or corner cover field of endeavor as US5639072 (MCCALL), providing first and second end sections (1) of a cover guard with connecting means (4) for securing the guard to a support surface by drawing the ends together.

US4867135 (STECKER) teaches, from the same edge and/or corner cover field of endeavor as US5639072 (MCCALL), providing fastening means (30, 38a) between individually formed covered foam panel section for attaching the panel pieces together to form the shape of a fireplace edge and corner guard assembly.

In regard to claims 1-9 and 11-17, for the purpose of securing the guard to a surface, such as a fireplace mantle, by drawing the ends together, it would have been obvious to a person having ordinary skill in the art to modify US5639072 (MCCALL) to include connecting means, in view of the teaching of FR2691435 (GENDRE).

In regard to claims 1-9 and 11-17, for the purpose of securing the guard to a surface (i.e. - fireplace mantle) by drawing the ends together, it would have been obvious to a person having ordinary skill in the art to modify US5639072 (MCCALL) to include connecting means, in view of the teaching of FR2691435 (GENDRE).

Regard to claim 9, Official Notice is taken that it is well known to provide materials with perforations to aide in selectively separating portions of the material for sizing (see for example, US440304, element (P); US5603140 element (12)). Thus, in view of that which is well known, to provide the foam portions of US5639072 (MCCALL) with sizing perforations, it would have been obvious to a person having ordinary skill in the art.

In regard to claims 12, Official Notice is taken that it is known to treat fabric with fireproof coating for the purpose of making the fabric less flammable. Thus, in view of that which is well known, to coat the fabric of US5639072 (MCCALL) with a fire-resistant layer, to

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reduce the likelihood of the fabric catching fire, would have been obvious to a person having ordinary skill in the art.

**Claims 10 and 19-25**

Claims 10 and 19-25, are rejected under 35 U.S.C. 103(a) as being unpatentable over US5639072 (MCCALL) in view of FR2691435 (GENDRE) and US4867135 (STECKER), as applied to claim 1 above, and further in view of US4514871 (FISHER).

US4514871 (FISHER) teaches, from the same edge and/or corner cover field of endeavor as US5639072 (MCCALL), covering padded edge guard sections with a first cover (25), second cover (49) and fastening means (53, 67) in a tensioned manner to secure cushioned sections of a corner guard relative to each other.

In regard to claims 10 and 19-25, for the purpose of secure cushioned sections of a corner guard relative to each other, it would have been obvious to a person having ordinary skill in the art to provide US5639072 (MCCALL) with a first cover, second cover and fastening means assembled in a tensioned manner, in view of the teaching of US4514871 (FISHER).

US4514871 (FISHER) teaches:

“(15) An end rail cap 29, constructed as described and cut to a standard size as appropriate before is placed over the bare foot rail 7, 9 of a water bed. Each convertible corner cap sections 49 is pulled and extended along existing, provided side rail caps 27a, b. The corner caps 49 are stretched taunt; the fasteners 67 are then engaged lengthwise with the mating fasteners 69 along both the inner and outer extreme edges of the side rails 27, fastening a sequence from adjacent to the end rail cap 29 along to the outer edge 59 of the

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convertible corner cap 49 so as to provide maximum tension along the convertible corner cap 49.

(16) This sequence, being done with both convertible corner caps 49 along both side rails 27a, b provides a tight, surface tensioned joint firmly affixing the end rail cap 29 to the side rail caps a, b. It provides a smooth, uniform appearing, relatively strong joint between the side rails 27a, b and the end rail 29. It has been found that it is unnecessary to provide any particular attaching means for the end rail cap 29 itself to the frame end rail 7, as a substantially extensive fastening force between the convertible cap 49 and the cover of the side rails 27a, b is transmitted by surface pull through the convertible corner cap 49 via the cover of the end rail cap to provide a strong clamping force, resisting any movement or loosening of the end rail cap 29."

#### **Conclusion**

See the attached PTO FORM for prior art made of record that is not relied upon, which is considered pertinent to applicant's disclosure.

#### **USPTO CUSTOMER CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Carl D. Price** whose telephone number is **(703) 308-1953**. The examiner can normally be reached on Monday through Friday, between the hours of **6:30 am** and **3:30 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ira Lazarus** can be reached on **(703) 308-1935**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (**PAIR**) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Carl D. Price', with a stylized flourish at the end.

Carl D. Price  
Primary Examiner  
Art Unit 3749